

REMARKS

Claims 1-9 are pending in the application. Claims 1-9 have been rejected.

Claims 5-6 and 8-9 are cancelled herein.

Independent claims 1 and 7 are amended herein to clarify applicant's claimed invention. The amendment highlights the claimed features:

- (a) that the orderwire controller (and its elements) is disposed in a junction node at which a plurality of ring networks meet;
- (b) that a plurality of mixing means each mix the orderwire signals of a specified group of ring networks; and
- (c) that the combination control means directs each mixing means which ring networks should form a group for sharing their orderwire functions.

Claims 1-5 are rejected under 35 U.S.C. §102(b) as being anticipated by Asai (U.S. 5,402,414) and claims 6-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Asai.

In the Office Action it is admitted that the cited reference does not disclose a plurality of ring networks. However it is respectfully submitted that applicant's claims contain a unique combination of elements and in contrast to the Asai reference, the present claimed invention is directed to an orderwire controller disposed in a junction node at which a plurality of ring networks meet.

Applicant's claimed invention is a unique combination of elements which would not have been obvious to one skilled in the art because all the elements are not described and even if they were there is no described motivation for such a combination other than from applicant's own disclosure and even if one skilled in the art would have been led in such a direction there would be an undue amount of experimentation required to arrive at applicant's unique combination of

elements.

The Office Action asserts that it is common knowledge in the art, stating: "it is a well-known skill in the art to connect the station SA to more than one ring of networks. Therefore, it would have been obvious to have a plurality of ring networks connecting the station SA in order to provide voice between networks."

However it is clear that the prior art does not show such a combination of elements and it respectfully submitted that applicant cannot judge the validity of such a bald statement of "well known" and cannot judge evidence of motivation other than from the applicant's own disclosure. A specific example of a plurality of ring networks sharing orderwire facilities is respectfully requested to be provided should the Examiner maintain this rejection.

It is well-established that a combination of limitations, some of which separately may be known, may be a new combination of limitations which is nonobvious under the condition of 35 U.S.C. 103. Moreover, "an examiner may often find every element of a claimed invention in the prior art." *In re Rouffet*, 47 USPQ3d 1453, 1457 (Fed. Cir. 1998) (reversing PTO obviousness rejection based on lack of suggestion or motivation to combine reference).

Therefore even if every element of a claimed invention is in the combined prior art there must be some suggestion or motivation to combine the references. "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form must nevertheless be 'clear and particularity.'" *In re Dembiscak*, 175 F.3d 994, 999 (CAFC 1999).

The only such suggestion provided has been from applicant's own disclosure. The Office Action only recites that it is "well-known" without providing any reference to judge this assertion by.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully respected. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted



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